

Request for Reconsideration:

Applicant respectfully requests that the Examiner reconsider the above-captioned patent application in view of the following remarks.

Remarks:

1. Rejections

Claims 1-5 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered obvious by Patent No. US 6,481,976 B2 to Kimura et al. ("Kimura") in view of U.S. Patent No. 5,332,365 to Taguchi ("Taguchi '365"). Applicants respectfully disagrees.

2. 35 U.S.C. § 103(a)

Claims 1-5 stand rejected as allegedly rendered obvious by Kimura in view of Taguchi. In order for the Office Action to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed by the Office Action. Second, there must be a reasonable expectation of success. Third, the prior art references must disclose or suggest all the claim limitations. MPEP 2143. For the reasons set forth below, Applicant maintains that the Office Action fails to establish a prima facie case of obviousness.

Applicants' independent claim 1 recites, in part: "a partition wall disposed around said valve element . . . whereby a gap is defined between said partition wall and said valve element for forming a non-contact structure." The Office Action appears to acknowledge that Kimura does not disclose or suggest this limitations, however, the Office Action asserts that Taguchi supplies this missing limitation. See, e.g., Office Action, Page 4, Lines 17-23. Specifically, the Office Action asserts that Taguchi discloses that "a pressure chamber, as defined by the chamber formed below element 482, is partitioned from a valve chamber, as defined by element 421a, by a fixed partition wall 482," and that it would have been obvious to

modify Kimura to include “a partition wall fixed [to] an inner surface of a valve chamber 47 . . . just below a port 53 communicating with a crank chamber and just above a moving plunger 44.” Applicant respectfully disagrees.

For example, Taguchi discloses a rod 481 positioned within an opening formed through a element 483. Nevertheless, there is no gap formed between element 483 and rod 481, such that element 483 and rod 481 do not form a non-contact structure. Therefore, even if Kimura were modified to include element 483, which the Office Action asserts corresponds to Applicants’ claimed partition wall, Kimura still would fail to disclose or suggest that “a gap is defined between said partition wall and said valve element for forming a non-contact structure,” as set forth in independent claim 1. Therefore, Applicant respectfully requests that the Examiner withdraw the obviousness rejection of independent claim 1 at least for this reason.

Claims 2-5 depend from allowable, independent claim 1. Therefore, Applicant respectfully requests that the Examiner also withdraw the obviousness rejection of claims 2-5 at least for this reason.

Conclusion:

Applicant respectfully submits that the above-captioned patent application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this application may be furthered by discussing the application, in person or by telephone, with Applicant's representative, Applicant would welcome the opportunity to do so. Applicant believes that no fees are due as a result of this submission. Nevertheless, in the event of any variance between the fees determined by Applicant and the fees determined by the PTO, please charge or credit any such variance to the undersigned's **Deposit Account No. 02-0375**.

Respectfully submitted,
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